

REMARKS

Claims 8, 34, 36-39, 42 and 44-53 are all the claims presently pending in the application. Claims 34, 36, 44, 26-28, 51 and 52 have been amended to more particularly define the claimed invention. Claim 53 has been added to claim additional features of the invention and to provide more varied protection for the claimed invention. Claims 35, 40, 41 and 43 have been canceled without prejudice or disclaimer.

Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Applicant gratefully acknowledges the Examiner's indication that claim 8 is allowed. However, Applicant submits that all of claims 8, 34, 36-39, 42 and 44-53 are allowable.

Claim 52 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 34, 36 and 50 stand rejected under claims 34, 36, and 50, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scisco ("Tend the Store for World Wide Orders") in view of Woolston (U.S. Patent No. 6,202,051). Claim 35 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Scisco and Woolston as applied to claim 34 above, and further in view of Wexler ("Screen Busters; Keyboard Troubles?"). Claims 37-40, 42 and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scisco and Woolston as applied to claim 34 above, and further in view of official notice. Claim 41 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Scisco, Woolston, and official notice as applied to claim 40 above, and further in view of Watanabe (U.S. Patent No. 5,717,776). Claim 43 stands rejected and further in view of Watanabe (U.S. Patent No. 5,717,776).

under 35 U.S.C. § 103(a) as being unpatentable over Scisco and Woolston, as applied to claim 34 above, and further in view of Galler (“IP: NYT Digital Commerce: Is Delivery the Dealbreaker for E-Commerce?”). Claims 44 and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scisco, Woolston and Galler as applied to claim 43 above, and further in view of official notice. Claims 46-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scisco, Woolston and Galler as applied to claim 43 above, and further in view of the official notice. Claim 51 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Scisco and Woolston as applied to claim 34 above, and further in view of official notice. Claim 52 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Scisco, Woolston and official notice as applied to claim 51 above, and further in view of Watanabe.

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention of exemplary claim 34, provides a method of operating a virtual shopping mall wherein each of the chain stores includes a terminal base unit for registering virtual goods information including an image, the terminal base units being connectable to the virtual shopping mall by a communication line (e.g., see Application at Figures 1 and 11, and page 13, lines 22-25). This allows the virtual shopping mall to be operated in a computer system without laying the burden for opening a virtual shop on a goods seller in the virtual shopping mall (e.g., see Application at page 3, lines 7-14).

II. THE INDEFINITENESS REJECTION

The Examiner alleges that claim 52 is indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner alleges that claim 52 does not provide proper antecedent basis for the limitation "the owner registration fee".

Applicant submits that claim 52 has been amended, above, to provide proper antecedent basis for all claim limitations. That is, claim 52 has been amended to recite "an owner registration fee".

Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. THE PRIOR ART REJECTIONS

A. The Alleged Combination of Scisco and Woolston (and further modified by Wexler, Watanabe, and/or Galler)

As detailed above (see Amendment at pages 9-10) the Examiner alleges that the alleged combination of Scisco and Woolston, as further modified by Wexler, Watanabe and/or Galler, teaches the claimed invention of claims 34-52. The Examiner, however, is clearly incorrect.

That is, neither Scisco, nor Woolston, nor Wexler, nor Watanabe, nor Galler, nor any combination thereof, teaches or suggests the specific shop terminal base unit as recited in the claimed invention (e.g., claims 34-52). Specifically, none of the cited references, taken alone or in combination, teach or suggest a shop terminal base unit

having a touch panel, a touch pen, a digital camera, a commercial goods purchase processing unit an a fee processing unit, as recited in the claimed invention.

Applicant submits that the Examiner's rejections are merely hindsight reconstructions of the claimed invention. While Applicant are aware that “[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning”, Applicant points out that the Examiner's rejection must take “into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper” (emphasis added by Applicant; see M.P.E.P. § 2145).

Furthermore, Applicant submits that “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious” (see M.P.E.P. § 2141.02; emphasis in M.P.E.P. itself).

Applicant submits that the Examiner is merely picking and choosing features from five (5) different cited references and, as discussed below, has additionally made numerous uses of official notice. Applicant submits, however, that the claimed combination of features, as a whole, would not have been obvious in view of the cited references.

Moreover, neither Scisco, nor Woolston, nor Wexler, nor Watanabe, nor Galler, nor any combination thereof, teaches or suggests “*an accommodating part for accommodating the digital camera therein*” or “*a commercial goods purchase processing unit which transmits, into the virtual shopping mall operation apparatus, information of a real shop where the goods are to be delivered, the information of the*

real shop being selected from the plurality of real stores by a buyer in accordance with a predetermined screen page displayed in said display device and being inputted from the input unit" (emphasis added by Applicant), as recited in exemplary claim 34.

Indeed, the Examiner does not even allege that the cited references (taken alone or in combination) teach or suggest either of these features of the claimed invention.

Therefore, the Examiner is respectfully requested to reconsider and withdraw these rejections.

B. Official Notice

Throughout the alleged prior art rejections, the Examiner has made numerous allegations that limitations in the claims are "well-known" by taking official notice (e.g., see the Examiner's rejections of claims 37-40, 42, 44-49 and 51. Applicant submits, however, that the Examiner's use of official notice throughout these rejections is improper.

That is, According to MPEP §2144.03, official notice that is unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known are capable of instant and unquestionable demonstration as being well-known. Furthermore, general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support those findings will not support an obviousness rejection (See MPEP §2144.03). Finally, if official notice is taken, the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or

her conclusion of common knowledge (See MPEP §2144.03). In the present Office Action, the Examiner does not supply any specific factual findings or concrete evidence to support his obviousness rejections based on official notice.

Therefore, the Examiner is respectfully requested to reconsider and withdraw these rejections.

IV. NEW CLAIM

New claim 53 has been added to claim additional features of the invention and to provide more varied protection of the claimed invention. This claim is independently patentable because of the novel features recited therein.

Applicant submits that claim 53 is patentable over any combination of the cited references at least based on analogous reasons to those set forth above with respect to claims 8, 34, 36-39, 42 and 44-53.

V. FORMAL MATTERS AND CONCLUSION

With respect to the Examiner's objection to the claims, the claims have been amended in a manner that is fully responsive to the Examiner's objections.

In view of the foregoing, Applicant submits that claims 8, 34, 36-39, 42 and 44-53, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

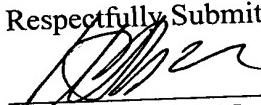
Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone

number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: February 6, 2007



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